

REMARKS-General

1. With regard to the rejection of record based on prior art, Applicant will advance arguments to illustrate the manner in which the invention defined by the newly introduced claims is patentably distinguishable from the prior art of record. Reconsideration of the present application is requested.

Response to Rejection of Claims 19-25 under 35USC103

2. The Examiner rejected claims 19-25 under 35USC103(a) as being unpatentable over Yamamoto (JP2003-109547) in view of Kling (US 6,175,197) and further in view of Borowiec (EP646941 A1). Pursuant to 35 U.S.C. 103:

“(a) A patent may not be obtained though the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

3. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

4. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Yamamoto which is qualified as prior art of the instant invention under 35USC102(b) are obvious in view of Kling and Borowiec at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

5. The applicant respectfully submits that the differences between the instant invention and Yamamoto are not obvious in view of Kling and Boroweic under 35USC103(a), due to the following reasons.

6. Regarding claim 19, Yamamoto fails to teach a magnetic light, comprising an air-filled light body which **comprises a glass tube** and an **air guiding tube**, and has an inner cavity, at least a through slot defined on the inner cavity, and a fluorescent layer coated onto the inner cavity, wherein **the glass tube is extended into the inner cavity**, and is communicated with the inner cavity for storing a predetermined amount of mercury.

7. The examiner acknowledges the absence of the glass tube and the air guiding tube, and refers to Kling as a teaching of these features. In response, the applicant respectfully submits that Kling merely teaches an electric lamp assembly comprising: an electrodeless lamp including an electrodeless lamp envelope enclosing a fill material for supporting a low pressure discharge, the electrodeless lamp further including an amalgam located within the lamp envelope; a transformer core disposed in proximity to the lamp envelope; **an input winding** disposed on the transformer core for receiving radio frequency energy from a radio frequency source, the radio frequency energy producing the low pressure discharge in the lamp envelope; and a thermal connection comprising a heat-conducting material disposed between the transformer core and the amalgam, wherein the amalgam is heated by the transformer core during operation.

8. In particular, Kling merely discloses an electrodeless lamp without any magnetic element. Moreover, the glass tube recited in the claim does not contain any amalgam which necessitates the functions embodied in Kling. According to Kling, "an enlarged, partial cross-sectional view of lamp envelope 12 and exhaust tubulation 72 is shown in FIG. 4. **Exhaust tubulation 72 contains an amalgam 104.** Transformer core 22 is disposed around lamp envelope 12 in close proximity to exhaust tubulation 72. Thermal bridge 90 is attached between core retainer 80 and exhaust tubulation 72, thus **providing a thermal connection between transformer core 22 and amalgam 104.** Alternatively, the thermal bridge may be connected directly between exhaust tubulation 72 and the transformer core. The thermal bridge 90 is fabricated of a thermally-conductive material, such as a thermally-conductive metal or a thermally-conductive

cement, and is secured so as to provide a thermal path between transformer core 106 and amalgam 104. The transformer core 22 and the exhaust tubulation 72 should be in relatively close proximity, preferably less than about 5 centimeters. In some cases, a separate thermal bridge may not be required for efficient thermal transfer between transformer core 22 and the amalgam. For example, an amalgam 112 may optionally be located on the inside surface of lamp envelope 12 adjacent to transformer core 22. In this case, conduction of thermal energy from transformer core 22 to amalgam 112 through the wall of lamp envelope 12 produces sufficient heating of amalgam 112 to obtain the improved performance described herein".

9. From the language of Kling, it is very clear that the exhaust tabulation 72 disclosed therein must work with the amalgam in order to provide a thermal bridge. The transformation core and the exhaust tabulation should also be in a relatively close proximity. This restriction substantially discourages one having mere ordinary skill in the art to take out parts of Kling invention, as what the examiner does, to combine these elements with other inventions. Nothing in Yamamoto and Kling motivate, suggest or teach the combinations of the elements as identified by the examiner.

10. The applicant respectfully submits that when a particular element is expressly disclosed that it must work with certain other elements, it is not obvious for one having no inventive capacity to take that element and combine it with some other elements to achieve different result. Such a combination would constitute an unobvious invention which should have pass the statutory muster under 35USC103(a). The applicant respectfully reminds the examiner that 35USC103(a) DOES NOT prohibit combination, but just obvious combination.

11. Moreover, Yamamoto fails to teach a magnetic body positioned in the through slot of the inner cavity, and is arranged to generate high frequency resonance toward the fluorescent layer, wherein the fluorescent layer, after the high frequency resonance, is then arranged to generate illumination having an enhanced luminous efficiency, extended life span and enhanced energy saving ability. The element identified by the examiner (2a) in Yamamoto is expressly disclosed to be a core. It is not by itself magnetic body. As a result, Yamamoto also fails to teach this particular feature of the instant invention.

12. The applicant respectfully submits that the patentable subject matter of the instant invention is not only the physical components identified by the examiner, but also the particular configuration of the various components. In the instant invention, there is no disclosure as to the particular configuration recited in claim 19. In the "Response to Arguments" section of the latest Office Action, the examiner merely recite the arguments presented by the applicant and concludes that the arguments "are not found persuasive" without stating the relevant reasons. In fact, the examiner fails to consider the particular configuration of the magnetic light of the instant invention.

13. The applicant respectfully submits that "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless **it is suggested by the prior art.**" *Libbey-Owens-Ford v. BOC Group*, 4 USPQ 2d 1097, 1103 (DCNJ 1987). In the instant invention, nothing in Yamamoto and Kling suggest the particular configuration of the magnetic light of the instant invention. In fact, the combination is merely a speculative imagination of the examiner.

14. While it is permissible to modify a reference's disclosure in the examination of patent applications, such modifications are not allowed if they are prompted by an applicant's disclosure, rather than by a reasoned analysis of the prior art and by suggestions provided therein. *In re Lesilie*, 192 USPQ 427 (CCPA 1977). In hindsight, the Examiner may feel that it would be obvious to combine the cited references to produce the instant invention. Such hindsight reconstruction **is not a permissible** method of constructing a rejection under 35 U.S.C. 103. *In re Warner and Warner*, 154 USPQ 173, 178 (CCPA 1967). The examiner argues that any obviousness assessment necessarily involves hindsight reconstruction. However, the examiner also acknowledges that hindsight reconstruction is only allowed to the extent that it is within the level of ordinary skill and does not include knowledge gleaned from applicant's disclosure. In the instant invention, the particular configuration is actually gleaned from the applicant's disclosure. The rule cited by the examiner DOES NOT APPLY.

15. The examiner also refers to Borowiec (US EP 646941) as a teaching of the glass tube for storing a predetermined amount of mercury. Borowiec discloses an amalgam accurately placed at a predetermined location of the SEF lamp for operation at a mercury vapor pressure in the optimal range. The amalgam is put at the tip of an extended exhaust tube. Again, the patentable subject matter of Borowiec's invention is

its distinctive configuration of the SEF lamp. As a result, when the examiner takes out one component from Borowiec and combines it with the disclosure contained in Yamamoto to come up with a completely different configuration of the magnetic light, it is hard to see why such a completely new configuration is devoid of any inventive steps. The Court of Appeal of the Federal Circuit has stated, "[V]irtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983). Thus, **"[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."** *In re Fine*, 5 USPQ 2d 1600 (Fed. Cir. 1988).

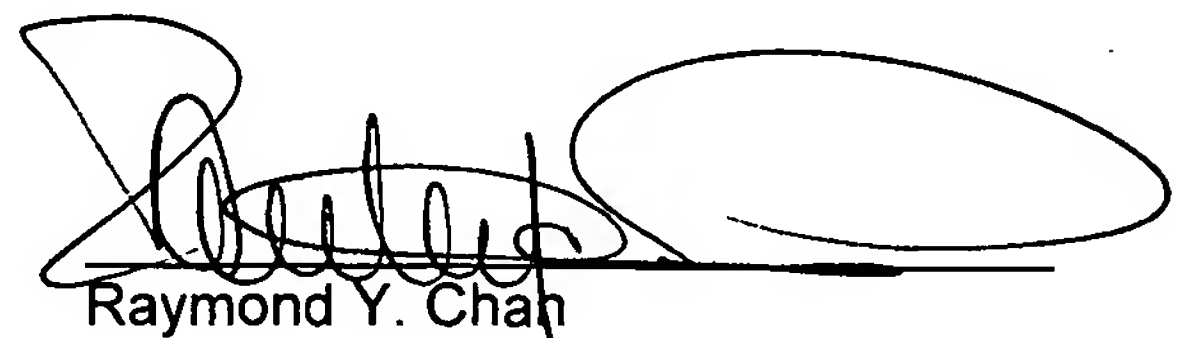
The Cited but Non-Applied References

16. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

17. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection are requested. Allowance of claims 19-25 at an early date is solicited.

18. Should the examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Raymond Y. Chan
Reg. Nr.: 37,484
108 N. Ynez Ave.
Suite 128
Monterey Park, CA 91754
Tel.: 1-626-571-9812
Fax.: 1-626-571-9813